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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/125,888 08/27/98 PETTERSSON

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QM32/0703

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EXAMINER

WHITE & CASE  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2787

ARNOLD III, T

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

07/03/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/125,888

Applicant(s)

Pettersson et al

Examiner

Troy Arnold

Group Art Unit

3728



☒ Responsive to communication(s) filed on Jun 15, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-26 is/are pending in the application

Of the above, claim(s) 12-26 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

Applicant's election with traverse of Group I in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the special technical feature, a silicon oxide-containing laminate, is present in each of the claimed inventions, and that it makes a contribution over the prior art. This is not found persuasive because, as can be seen below (and as was admitted in applicant's own specification on page 2), the silicon oxide-containing laminate, as claimed in the instant application, does not make a contribution over the prior art, i.e. is not patentable, and therefore does not link the different distinct inventions. Upon reconsideration however, the requirement for restriction between the container per se and the laminate has been withdrawn and the groups to the laminate and container as amended have been rejoined and examined herein.

Claims 12-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups II, III, IV and V, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones.

Regarding claims 1 and 2, Jones teaches a laminate having 1) an inner layer comprising a polyolefin, 2) an outer layer comprising a polyester, polyolefin or polyamide, and 3) an intermediate layer comprising silicon oxide. See Fig 1 and column 4, lines 19-33 where Jones describes an inner layer comprising polyethylene, a polyolefin. (Polyethylene is a polyolefin, as defined in Webster's Collegiate Dictionary, 10th edition.) See column 5, lines 29-33 for a description of an outer layer comprising a polyamide. See column 4, lines 34-59 for a description of an intermediate layer comprising silicon oxide. Regarding claim 3, see column 8, lines 1-25 where the use of polyethylene terephthalate is clearly disclosed as one (inner or outer) of the layers. See also Toyo Boseki KK, European Patent No 0550039 A2 lines 21-33 where the use of polyethylene terephthalate as a layer material is taught, and also page 2, lines 18-26 of the specification of the instant application where the use of polyethylene terephthalate as a layer, specifically an outer layer, is disclosed as known in the art. Regarding claim 4, Webster's Dictionary describes polyamides as "a polymeric amide (as nylon)," and Jones covers all polyamides. Claim 5 is clearly taught in Fig 1.

The intended use phrasing employed in claims 1-10 has been given no patentable weight. The phrase "Use of....in the manufacture of a barrier material to ethylene oxide gas" outlines an

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intended use of the invention but does not recite further structural limitations. In addition, patents are not granted for newly discovered capabilities that a previously patented invention inherently possessed, or for newly discovered manners of use for which it was suited but not known to be used. See *In re Inman*, 43 CCPA 706, 228 F2d 226, 108 USPQ 138; *In re Tanczyn*, 44 CCPA 764, 241 F2d 731, 112 USPQ 483 and *In re Kelly*, 43 CCPA 816, 230 F2d 435, 109 USPQ 42.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Toyo Boseki KK, European Patent No 0550039 A2 and Oike Ind Co, Japanese Patent No. 5084276. It is clear that there are many different layering possibilities or permutations for a laminate structure, and it is also clear that there are many different “genus,” “species,” or sub “sub-species” of materials, generically referred to as plastics, which could be employed as the layering materials for a laminate. All of the materials specifically claimed in the instant application are taught in at least one of the three prior art references above, and they all discuss many alternative material and layering arrangements. It would have been obvious in view of the references to one of ordinary skill in that art at the time the invention was made to modify the

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laminate of Jones to incorporate any of the limitations in claims 1-10, for the purpose of suiting a given condition, or mechanical or chemical expedient.

Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Toyo Boseki KK, European Patent No 0550039 A2. Toyo teaches an intermediate layer comprising silicon oxide and polypropylene or polyvinyl alcohol or polyethylene terephthalate or nylon. It would have been obvious in view of Toyo to incorporate any one of these materials into the intermediate layer of Jones for the reasons discussed above.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Troy Arnold whose telephone number is (703)305-0621. The Examiner can normally be reached Monday through Friday from 9:00 am until 5:00 pm EST. Any questions of a general nature pertaining to the application can be directed to the group receptionist whose number is (703) 308-1148.

TGA

June 27, 2000



Paul T. Gowell  
Supervisory Patent Examiner  
Group 3730